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ALBANY, NY 12207				

  

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06/30/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/998,111	HUBBARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 May 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 13-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 13-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/30/07.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 13-24 have been examined.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/08 has been entered.

### ***Response to Amendment***

Examiner notes that this RCE is filed after the BPAI Affirmed the rejections of this case on 3/17/08. Hence, the BPAI decisions is considered definitive as far as the rejection of the claims dated 3/24/06. Applicant has amended the claims on 5/19/08. Hence, given the BPAI decision Affirming the rejection, only the amended features need be demonstrated as obvious by the prior art.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 13-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 13 dated 5/19/08 states, ““(b) storing said data items in said one of a plurality of marketing page elements, every marketing page element being of a different type, according to a style of presentation employed and providing a framework for the data items.”

However, the words or phrases “style”, “style of presentation”, or “framework” do not appear in the same paragraph as “marketing page element”. Hence, these features are unsupported by the Specification. Also, it is unclear how these features function.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Cantrell (2002/0103698).

Claim 13: Gerace discloses a method for presenting marketing content on a web page, the system comprising:

- (a) a marketing page element, said marketing page element providing storage for data items (Fig. 2; Fig. 3a);
- (b) a web page connected to said marketing page element for presenting said data items (Fig. 2; Fig. 3a); and
- (c) a marketing content selection system connected to said marketing page element, wherein said marketing content selection system is adapted to select said data items to be stored in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37; col 5, lines 40-53; Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 4, lines 39-45; col 16, lines 55-67).

Additionally, Gerace discloses a marketing page element placed on the web page and that these components are for placing on a web page (col 1, lines 30-45; col 1, lines 60-65; col 6, lines 45-52; col 17, lines 60-67; col 20, lines 10-20; col 16, lines 36-55; col 14, lines 25-35; col 2, lines 24-30; col 4, lines 25-30;).

Gerace discloses design of a webpage and marketing strategy for determining marketing content (col 5, lines 19-24; col 20, lines 10-20; col 12, lines 21-56; col 18, lines 10-26).

Gerace discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace does not explicitly disclose that a marketing element can be placed anywhere on the webpage.

However, Gerace discloses advertisements placed in a variety of locations including top, bottom, sides, beginning and end as disclosed above and in the Applicant's Amendment dated 2/22/05 on page 19.

Also, Gerace discloses that advertisements can be a form of agate information:

"(18) In accordance with another aspect of the present invention, there are Agate Objects for providing the agate information and a Sponsor Object. In a preferred embodiment, the agate information includes stock information, advertisements, sports statistics, weather reports and the like. With regard to stock information, an Agate Object routine receives stock data on line, parses the data and makes a value-added calculation. As a result, the stock information is made searchable by variables such as price-earnings ratio, and the like" (col 2, line 60-col 3, line 5).

Therefore, the functionality in Gerace concerning agata data can also apply to advertising data.

Also, Gerace discloses that agate information can be placed anywhere on the web page:

"(19) Display preferences include orientation, color scheme, screen quadrant/location and the like, indicated with respect to the category of information (col 6, lines 30-35);

(48) Also, categories that a user selects to view further which are not on his Home Page are added with three options: customize, remove from first page, or move to a user-specified xyz position" (col 11, lines 50-56).

Therefore, it would be obvious to Gerace that a marketing page element can be placed anywhere on the webpage.

Also, note that the BPAI decision dated 3/17/08 confirmed that it is obvious that a marketing page element can be placed anywhere on the webpage (page 4, facts 4 and 5).

Also, Gerace's that advertisements can be for a marketed item:

"(15) In accordance with another aspect of the present invention, there is a module (e.g., advertisement module) that records history of users viewing the advertisements. For each advertisement, the module records (i) number of times viewed by a user; (ii) number of times selected for further information by a user, and/or (iii) number of purchases initiated from display of the advertisement to a user" (col 2, lines 35-42).

An advertisement that results in a purchase is equivalent to presenting data items related to a marketed item such as a product or coupon.

Gerace discloses utilizing a marketing strategy for selecting the marketed item that is displayed on a web page:

"(82) Based on these recorded details, program 31 constantly and automatically tailors screen views (content and presentation) and advertisement selection (subject matter and

presentation) for the user (col 17, lines 4-10);

(14) The tracking and profiling member also records demographics of each user. As a result, the data assembly is able to transmit advertisements for display to users based on psychographic and demographic profiles of the user to provide targeted marketing (col 2, lines 30-35);

(90) For example, a report comprises several defined elements, including overall success of the advertisement, breakdown by requested demographic elements, comparison of target market with control group, number of click through requested versus number achieved to date, as well as the time remaining in an advertisement. Finally, program 31 completes a regression analysis using data stored in Ad Package Objects 33b and User Objects 37, and suggests other demographic groups which a sponsor might want to consider for a subsequent ad (col 18, line 64-col 19, line 6);

(97) In order to achieve rapid and direct benefits from the detailed reporting of program 31, program 31 allows the sponsor to enter new advertising contracts on line. If a sponsor recognizes that, for example, 25-35 year-old women tend to purchase frequently and respond to their still, forest green colored advertisements most often, program 31 allows sponsors to place that type of ad in front of the subject target market segment during a reporting cycle. Thus, program 31 enables updating of the Sponsor and Ad Objects 33 during a reporting cycle to accommodate the foregoing (col 20, lines 9-19);

[Claim] 6. Apparatus as claimed in claim 5 wherein the tracking and profiling member further provides demographic information about a user; and for each

advertisement, the data assembly transmits the advertisement for display with aggregate information to users having a psychographic profile and a demographic profile substantially matching the target profile of the advertisement to provide targeted marketing (col 35, lines 14-20);

(98) With respect to reporting, if the reports of program 31 show that customers respond to still advertisements more often than moving ones, bright colors more often than darker ones, graphics rather than text, large text rather than small, detailed text or square advertisements rather than bar style ones, such is relayed to the sponsors/advertisers (col 20, lines 10-25).

(55) Briefly, an Overview Report provides a review by ad package. The number of hits and number of click throughs purchased and achieved are indicated among the cost of the package and date specified by the ad package" (col 12, lines 62-69).

Hence, Gerace discloses that advertisements can be displayed to users, that advertisements can be utilized to incite purchases from users. Gerace further discloses that certain advertisements can be targeted to certain markets or groups of users and that certain advertisements can be displayed to users in certain ways in order to illicit more favorable responses, such as purchases, from a user. Therefore, Gerace discloses utilizing a marketing strategy for selecting the marketed item that is displayed on a web page.

Additionally, in regards to the claim amendments dated 5/19/08:

"(a) selecting a plurality of data items, every data item identifying a marketed product ", these features are obvious.

The BPAI decision dated 3/17/08 on page 8 stated that these features were rendered obvious by Gerace. Gerace further discloses that the data item identifies a marketed product (col 2, lines 35-42). Also, please see the citations above.

Also, Gerace does not explicitly disclose:

"(b) . . .one of a plurality of marketing page elements, every marketing page element being of a different type, according to a style of presentation employed and providing a framework for the data items."

However, Gerace discloses sending a particular ad style or "type of ad" based on different target criteria (col 20, lines 9-19) and also that there are a variety of ad styles or types of ad (col 20, lines 19-25).

And, Cantrell discloses ". . .one of a plurality of marketing page elements, every marketing page element being of a different type, according to a style of presentation employed and providing a framework for the data items" (Figures 4, 5, 16, 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cantrell's ad templates/styles/types for different advertisement types to Gerace's sending a variety of different ad formats. One would have been motivated to do this in order to better and more easily presents ads of interest to the user.

Claim 14: Gerace further discloses that said marketing page element comprises a plurality of marketing page element items, and wherein at least one data item stored in said marketing page element is connected to one of said plurality of marketing page

element items (Fig. 4a; col 4, lines 23-29; col 16, lines 41-47; col 17, lines 1-5; col 16, lines 24-29).

Claim 15: Gerace further discloses that said web page comprises a plurality of web page elements, wherein each of said web page elements is connected to a marketing page element item of said plurality of marketing page element items, and wherein each of said web page elements is used to present a data item connected to said marketing page element item (Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 16: Gerace further discloses that said marketing content selection system is adapted to determine data items for storage in said marketing page element in accordance with a marketing strategy (col 12, lines 21-42; col 13, lines 10-20).

Additionally, Gerace discloses utilizing if-then logic related to a marketing strategy:

“(97) If a sponsor recognizes that, for example, 25-35 year-old women tend to purchase frequently and respond to their still, forest green colored advertisements most often, program 31 allows sponsors to place that type of ad in front of the subject target market segment during a reporting cycle. Thus, program 31 enables updating of the Sponsor and Ad Objects 33 during a reporting cycle to accommodate the foregoing.

(98) With respect to reporting, if the reports of program 31 show that customers respond to still advertisements more often than moving ones, bright colors more often than darker ones, graphics rather than text, large text rather than small, detailed text or

square advertisements rather than bar style ones, such is relayed to the sponsors/advertisers" (col 20, lines 10-25).

Also, note that the targeted marketing features, including targeting both advertising content and advertising format to certain target user(s), disclosed in the rejection of the independent claim above and in the immediate citations above constitute utilizing a marketing strategy and a business rule. For example, the business rule would be something like if a target age group can be identified that responds to certain advertisements more favorably, then market that age group with that type of advertisement.

Claim 17: Gerace further discloses that the marketing content selection system determines data items to be stored in said marketing page element based on information available to said marketing content selection system pertaining to the person viewing the web page (Fig. 3b; col 4, lines 20-35).

Additionally, Gerace further discloses taking the information currently displayed on the web page into account (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5).

Gerace further discloses determining marketing content based on a combination of information displayed on the webpage and information available pertaining to the person viewing the web page (col 16, lines 36-55; col 14, lines 25-35; col 10, line 64-col 11, line 5; col 2, lines 30-35).

Claim 18: Gerace further discloses a marketing content retrieval system connected to said marketing page element, said marketing content retrieval system

adapted to provide said data items to said marketing page element for storage in said marketing page element (Fig. 2; Fig. 3a; col 5, lines 54-63; col 7, lines 24-37).

Claim 19: Gerace further discloses that the marketing content retrieval system comprises a first source of data items, wherein data items are retrieved from said first source of data items for subsequent storage in said marketing page element, said first source of data items comprising at least one of the following: a database, a data stream, a storage device, a memory device (Fig. 2; Fig. 3a; col 3, lines 54-62; col 3, lines 39-42).

Claim 20: Gerace further discloses that each data item in said first source of data items comprises one of the following: text, an image, an audio file, a video file, a movie, a document, a hyperlink, an animation, an object capable of accepting input, an object capable of presenting output (col 1, lines 31-44).

Claim 21: Gerace further discloses that the marketing content retrieval system is further adapted to provide at least one data item to said marketing page element from a pre-determined second source of data items in the event that at least one data item to be stored in said marketing page element as determined by the marketing content selection system cannot be retrieved from the first source of data items (col 16, lines 55-67; ).

Claim 22: The prior art discloses the above.

Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Java Server Pages or Data Beans can be used by Gerace's utilization of Java, servers, the Internet, and webpages. One would have been motivated to do this in order to provide greater architecture flexibility and platform independence.

Also, note that the BPAI decision on 3/17/08 confirmed that this is obvious (page 5, fact 8; pages 10, 11).

Claim 23: Gerace further discloses that the marketing content selection system comprises at least one of the following components: a rules processing engine, a table, a collaborative filtering engine, a selection program (col 16, lines 37-48; col 3, lines 56-61).

Claim 24: Gerace further discloses at least one of the following:

- (i) a first set of tools for making modifications to the manner in which the marketing content selection system determines the data items to be stored in said marketing page element, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or said data items (col 11, lines 24-36; col 11, lines 45-56);
- (ii) a second set of tools for making modifications to said data items, wherein the modifications can be effected without changing either the layout of said web page elements on said web page or the manner in which the marketing content selection

system determines the data items to be stored in said marketing page element (col 11, lines 50-55; col 20, lines 13-15; col 6, lines 31-35); and

(iii) a third set of tools for making modifications to the layout of said web page elements on said web page, wherein the modifications can be effected without changing either said data items or the manner in which the marketing content selection system determines the data items to be stored in said marketing page element (col 6, lines 31-40; col 17, lines 1-5).

Claims 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerace (5,848,396) in view of Cantrell (2002/0103698) and in further view of Petty (6,342,907).

Claim 22: The prior art discloses the above.

Gerace further discloses the utilization of Java and other formats (col 13, lines 51-55) and the utilization of web pages and servers (col 3, lines 54-58; col 1, lines 29-45).

Gerace does not explicitly disclose the utilization of Data Bean or a Java Server Page.

However, Petty implies the utilization of Java Server Pages and discloses the utilization of Data Bean (col 5, lines 20-25; col 9, line 65-col 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Java Server Pages and Petty's Data Beans to Gerace's utilization of Java, servers, the Internet, and webpages. One would have

been motivated to do this in order to provide greater architecture flexibility and platform independence.

### ***Response to Arguments***

Examiner notes that this RCE is filed after the BPAI Affirmed the rejections of this case on 3/17/08. Hence, the BPAI decisions is considered definitive as far as the rejection of the claims dated 3/24/06. Applicant has amended the claims on 5/19/08. Hence, given the BPAI decision Affirming the rejection, only the amended features need be demonstrated as obvious by the prior art.

In regards to the new features dated 5/19/08 of:

“(a) selecting a plurality of data items, every data item identifying a marketed product “, these features are shown as obvious.

The BPAI decision dated 3/17/08 on page 8 stated that these features were rendered obvious by Gerace. Gerace further discloses that the data item identifies a marketed product (col 2, lines 35-42).

In regards to the new features dated 5/19/08 of:

“(b) storing said data items in said one of a plurality of marketing page elements, every marketing page element being of a different type, according to a style of presentation employed and providing a framework for the data items.”

Please see the addition of the Cantrell reference to the rejection of the independent claim above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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6/19/2008